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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,813	01/15/2004	Donald C. Roe	7294C	5408

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/757,813	<b>Applicant(s)</b> ROE ET AL.	
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-9-04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 8-9 and 13-14, i.e. a storage member of a plurality of looped strands of fibers, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because Figure 8 is not consistent with the description thereof on page 4, i.e. the Figure is shown in cross section but is not described as such. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Description*

3. The abstract of the disclosure is objected to because the legal terminology, i.e. “comprising”, should be avoided. Correction is required. See MPEP § 608.01(b).

4. The use of the trademark PAMPERS(page 34, Table V) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The disclosure is objected to because of the following informalities: 1) On page 1, lines 10-12, the cross reference should be updated, i.e. the parent application has issued into a patent. Furthermore, where in the parent application is there support for the apertures having a “size” rather than an “effective aperture size” as now claimed in claim 1 and “at least one” in claims 3 and 11 as well as the trade name bridging lines 25-26 of page 7, i.e. is this application a continuation or a continuation in part of the parent application? 2) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d). 3) On page 4 the description of Figure 8 is inconsistent with Figure 8 as shown, see also discussion supra. 4) On page 15, last line “accept” should be --“accept”--. 6) The equations bridging pages 43-44 and 44-45 should be amended to appear on one page rather than 2. 7) On page 45, line 17 and page 48, line 16 the underlining should be removed. 8) In claims 5 and 15, Applicant sets forth “a nominal size” of the particle structure with dimensions of mm. “Nominal” as defined by the dictionary means “insignificantly

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small; trifling”. However, it is unclear on page 27, last paragraph, what dimension of the particle this size is referring to, i.e. any dimension? A specific dimension? A clear description of the structure which has such size should be set forth. Note also the paragraph bridging pages 28-29.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: positive antecedent basis for the apertures each having an area, as compared to an effective aperture size, as claimed in claim 1, the effective open area as claimed in claims 2 and 10, and “at least one” in claims 3 and 11 should be set forth.

#### ***Claim Language Interpretation***

7. The claim language is interpreted in light of the definitions set forth in the paragraph bridging pages 5-6. Any other claim terminology which has not been specifically defined will be interpreted in light of its broadest common definition. Therefore, in claims 1 and 10, it is claimed that the acceptance member is disposed “adjacent” to a bodyside surface of the backsheet. Since the term “adjacent” has not been specifically defined, the dictionary definition, i.e. “Close to, lying near”, will be applied. It is noted that the terminology “near” is considered relative. It is also noted claims 4 and 12 recite the element being a portion of the topsheet. Note page 21, line 18-page 22, line 3 of the instant specification. Therefore, an acceptance element anywhere on the article on the body side of the backsheet will be deemed to meet the independent claims and an acceptance element forming a portion of the topsheet will be deemed to meet claims 4 and 12. Also in light of the discussion supra, with respect to the language “a

nominal size” in claims 5 and 15, such language will be considered to be met by any dimension of particulate structure of between about 1mm and about 10mm.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al ‘208, and thereby Thompson ‘135, Kimberly-Clark EP ‘417, Moore et al ‘642 and Lash et al ‘022.

Claim 1: See Claim Language Interpretation section supra and Thompson ‘208 at Figures, col. 5, lines 39-44, col. 7, line 57-col. 8, line 6, col. 14, line 41-col. 19, line 2, and thereby Thompson ‘135 at especially the Figures and the entire disclosure of EP ‘471, col. 9, line 54-col. 14, line 38, col. 21, line 30-col. 21, line 2, and thereby Moore ‘642 at col. 1, lines 46-62 and Lash et al ‘022 at col. 4, line 29-col. 6, line 35 and col. 14, lines 55-58 and 64 et seq, i.e. Thompson et al teaches a disposable absorbent article for wearing on or about a lower torso of a wearer for receiving bodily exudates which comprises a topsheet, , e.g., 9, a backsheet, e.g., 12, joined with the topsheet, an absorbent core, e.g., at least a layer of 11, an acceptance element, i.e. at least a portion of the topsheet which comprises at least one aperture having an area of between 0.2 sq. mm to 25 sq. mm (See Thompson ‘208 at col. 15, line 61-col. 16, line 12 and the paragraph bridging cols. 18-19, i.e. EP ‘417 teaches filaments of a certain diameter, a topsheet

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having a certain number of filaments per square inch to define openings of equal size therebetween, i.e. the area between the filaments per sq. inch calculated from such disclosed specifics includes apertures having an area as claimed), and a storage element, e.g., 10 or a layer of 11, between the acceptance element and the backsheet. Claim 1 further requires the storage element to have a compressive resistance of at least about 70%. While Thompson '208 teaches a layer 10 having resilience and a ratio of wet to dry caliper of at least 80%, and preventing flow interference while being form fitting and a layer 11 of curled, twisted, chemically stiffened and crosslinked fibers, such fibers having increased dry resilience, i.e. the ability to return toward an expanded original state upon release of a compressional force applied thereto, and retaining their configuration during use at the portions cited supra, Thompson et al does not teach such layers having a compression resistance of at least about 70%. It is however noted that at page 29, lines 8-23 of the instant specification that Applicants while expressing the desire for the storage element to resist compression when a force is applied to maintain a significant level of storage capacity and restore itself to substantially its original thickness when the force is removed, does not disclose the criticality of the specific resistance claimed, i.e. the criticality of 70% rather than 45% for example. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a compressive resistance of at least about 70% on the Thompson et al device since it has been held that where the general conditions of a claim are disclosed in the prior art as in the instant case, i.e. see discussion supra, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 105 USPQ 233.

Claims 3-4: See portions of Thompson '208 and '135 cited with respect to claim 1 supra.



Claims 5-6: See portions of Thompson '208 and Lash et al '022 cited with respect to claim 1 supra, i.e. layer 11 includes layers having absorbent particles of the claimed size.

Claims 5 and 7: See portions of Thompson '208 cited with respect to claim 1 supra, and paragraph bridging pages 28-29 of the instant application, i.e. layer 10 includes nonabsorbent, fibers, i.e. particles, with wettable surfaces, i.e. liquid insensitive fibers, which fibers have a dimension of the nominal size claimed.

Claims 8-9: See portions of Thompson '208 cited supra with regard to claim 1, see, e.g., Figures 1-7.

Claims 2 and 10-17: Applicant claims the acceptance element having an effective open area of at least 22.5%. However, see page 25, lines 2-5, of the instant application, and thereby Roe '338. Furthermore, see again the portions of Thompson '208 and EP '417 cited supra, i.e. the topsheet of Thompson et al includes an open area of 30-60% for enhanced acceptance of fluid. Therefore, it is the Examiner's first position that there is sufficient factual evidence for one to conclude that the topsheet of Thompson '208 would necessarily and inevitably include the claimed "effective open area" when tested according to the test set forth in Roe '338.

Alternatively, the Examiner's second position, Thompson '208 teaches a topsheet which receives or accepts fluid. It is however noted that while at page 23, lines 8-13 of the instant specification Applicants express the desire for the acceptance element to pass waste therethrough, the criticality of the specific effective open area claimed enabling the element to do so is not set forth, i.e. the criticality of 22.5% is not set forth at all. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an effective open area of at least about 22.5 % on the Thompson et al device, if not already, since it has been held

that where the general conditions of a claim are disclosed in the prior art as in the instant case, i.e. see discussion supra, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,703,537 in view of Roe '338. Although the conflicting claims are not the identical, they are not patentably distinct from each other because since the filing date of the application is the same as or after that of the patent, the one way *In re Vogel* test applies, i.e. are the claims of the application obvious in view of the claims of the patent? The answer is yes. The claims of the application are either 1) broader with respect to the claims of the patent, e.g. they claim a larger range of effective open area, i.e. 22.5% rather than 30% effective open area, they don't claim Storage under Pressure values or Acceptance under Pressure values, they claim a broader class of materials of the storage element, or 2) narrower than the claims of the patent, e.g. they claim the acceptance

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element having apertures of a specific size, specific topsheet materials, a specific location of the acceptance element. With regard to 1), once applicant has received a patent for a species or more specific embodiment, the Applicant is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. The patent claims anticipate the applications claims. See *In re Goodman*, supra. With regard to 2), see Roe '338 at Tables I and II, element 24 in the Figures and col. 8, lines 5-16, i.e. an element which accepts fluid and has an effective open area of at least about 22.5% comprises more than one aperture having an area between about 0.2 sq. mm and about 25 sq. mm and comprises a portion of the topsheet, i.e. disposed adjacent to the body side surface of the backsheet, and is made of the claimed materials. To make the acceptance element of the patent claims an acceptance element not only having an effective open area as claimed but comprising a portion of the topsheet, formed of the claimed materials and having more than one aperture of the claimed area as taught by Roe '338 would be obvious, see *In re Siebentritt*, 54 CCPA 1083 (two equivalents are interchangeable for their desired function, express suggestion of desirability of substitution not needed to render obvious), i.e. desired function in the instant case is an acceptance element having a specific effective open area.


### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
August 8, 2005